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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/764,936 | 01/18/2001 | Roland Eberlein | 4965-000114 | 9936 |

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EXAMINER

ODLAND, KATHRYN P

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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3743

DATE MAILED: 02/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/764,936

Applicant(s)

EBERLEIN ET AL.

Examiner

Kathryn Odland

Art Unit

3743

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) 14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 14 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

This is a response to the amendment dated December 29, 2003. Claims 1-13 are pending. Applicant's amendment on page 5, states that claim 14 was previously presented. However, this is a newly added claim drawn to a different species of the invention. Thus, it will not be examined. The amendment to the title is acknowledged. The arguments regarding the 35 U.S.C. 112 rejections have been considered and the 35 U.S.C. 112 rejections have been withdrawn. The amendments to address the claim objections are acknowledged.

Election/Restrictions

1. Newly submitted claim 14 is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: it is directed to Figure 6 where the fixing element 78 does not have a spherically shaped inner surface. This is clearly a distinct species from that of claim 1, where the inner surface is spherically shaped,

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 14 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Response to Arguments

2. Applicant's arguments filed December 29, 2003 have been fully considered but they are not persuasive. Applicant's arguments have been carefully considered;

however, there seems to be some contradictions between applicant's arguments and that presented by the examiner in the Office Action of September 29, 2003. Applicant argues "In Stoffer et al., the ball nut 83, which corresponds to the bushing in claim 1..." is different than that of the claimed invention. The examiner asserts that the Office Action dated September 29, 2003 the bushing is considered to be element (67), not element (83). Thus with regard to applicant's arguments:

- a. Stoffer et al. fail to teach or suggest a hole having an inner surface that is formed about spherically curved. However, Stoffer et al. do have a hole having an inner surface that is formed about spherically curved. An Appendix has been provided showing the spherically curved portion in green.
- b. Stoffer et al. fail to describe fastening a fixing element to a substructure. However, given that the bushing is (78) the substructure is the ball nut (83).
- c. Stoffer et al. fail to teach or suggest at least one bushing arranged in the at least one bore, through which the screw can be passed for screwing the screw into the substructure. However, given that the at the at least one bushing is element (67), the bushing is arranged in the bore and the screw passes into the substructure, as seen in figure 5.
- d. Stoffer et al. fail to teach or suggest a bushing further having a seat for at least partially receiving at least a partial surface of the head of the screw. However, again given the bushing is element 67, not element (83), there is a seat, shown in red in an Appendix that has been provided.

Thus, applicant has failed to provide structural features that define over the prior art of record. The rejection is reiterated below.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Stoffer et al. in US Patent No. 4,971,497.

Stoffer et al. disclose a fastening assembly having:

- A fixing element (65) to be fastened to a substructure where the fixing element has at least one bore, as seen in figure 5
- At least one screw (64) which can be passed through the at least one bore of said fixing element, and which can be screwed into said substructure, said screw having a shaft and a head, as seen in figures 5-8
- At least one bushing (67) arranged in said at least bore, through which said screw can be passed for screwing said screw into said substructure, said bushing being able to swivel in several spacial directions when seated in said bore, said bushing further comprising a seat for at least partially receiving at least a partial surface of said head of said screw, as recited in column 4, lines 50-68, column 5, and seen in figures 5-8

Wherein an inner surface of said bore and an outer surface of said bushing are formed to be about spherically curved, such that a region of largest diameter of said inner surface and said outer surface is situated between an upper edge and a lower edge of said bore, wherein said bushing is loss-proof pressed in [in] said bore.

With respect to the "wherein" clause, it has been held that the functional "whereby" and "wherein" statements do not define any structure and accordingly cannot serve to distinguish. In re Mason, 114 USPQ 127, 44 CCPA 937 (1957). Functional language is not given patentable weight in apparatus claims. Nonetheless, Stoffer et al. disclose an inner surface of said bore and an outer surface of said bushing are formed to be about spherically curved, such that a region of largest diameter of said inner surface and said outer surface is situated between an upper edge and a lower edge of said bore, as seen in figure 5. Furthermore, it can be considered that the bushing is "loss-proof" since the current application specification does not define "loss-proof"

Regarding claim 2, Stoffer et al. disclose a symmetry axis of said bushing that can be swiveled preferably over an entire azimuth angle of 360.degree. in an angular range of 0.degree. to at least 45.degree. with respect to a symmetry axis of said bore, as discussed in column 5 and seen in figures 5-8.

Regarding claim 3, Stoffer et al. disclose a bushing that is mounted directly in said bore, as seen in figures 5-8.

Regarding claim 4, Stoffer et al. disclose a bushing that is received in said bore in form-locking manner. It can be considered that the bushing is "form-locking" since the current application specification does not define "form-locking."

Regarding claim 5, Stoffer et al. disclose a bushing that is received to be swiveled in said bore through a bearing element (such as 83), which can be fixed to said fixing element and which is arranged in said bore, and wherein in this case an inner surface of said bearing element is about spherically curved, such that a region of largest diameter of said inner surface and said outer surface is situated between an upper edge and a lower edge of said bearing element, wherein said bushing is *loss-proof* pressed in said bearing element, as described in column 4, lines 50-68, column 5 and seen in figures 5-8.

Regarding claim 6, Stoffer et al. disclose a head of said screw and said seat of said bushing form a substantially form-locking connection. It can be considered that the bushing is "form-locking" since the current application specification does not define "form-locking."

Regarding claim 7, Stoffer et al. disclose a head of said screw and said seat of said bushing are formed conically to be complimentary to one another, as seen in figures 5-8.

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Regarding claim 8, Stoffer et al. disclose an upper edge of said seat of said bushing that is rounded, as seen in figures 5-8. The claim does not limit the direction in which the bushing is rounded. Therefore, given a reasonably broad interpretation of the term "rounded," the top of the bushing is rounded in a circumferential direction as seen in figures 5-8.

Regarding claim 9, Stoffer et al. disclose a periphery of said head of said screw is configured as a support surface, which in the tightened condition of said screw rests against a support surface of said bushing formed to be approximately complimentary to said support surface of said head, as recited in column 4, lines 50-68, column 5 and seen in figures 5-8.

Regarding claim 10, Stoffer et al. disclose a bushing that has **approximately** the same height as said bore, and wherein said head of said screw has approximately the same height as said seat of said bushing, as seen in figures 5-8.

Regarding claim 11, Stoffer et al. disclose a bushing that is **integrally formed of metal or of synthetic material**, or comprises a metal body with said seat of said bushing then being at least partially coated with synthetic material, as recited in column 3, lines 18-33.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stoffer et al. in US Patent No. 4,971,497.

Stoffer et al. disclose the invention with the exception of explicitly reciting securing a bone fracture in a human body, wherein said fixing element is a rigid plate or a rigid brace and said at least one screw is a bone screw or mounting an object on a wall, wherein said fixing element is comprised in the group of a wall fixture, a profile or the like, or for assembling furniture or the like, wherein said fixing element is comprised in the group of an armature, a hinge, an angle or the like. However, this language is intended use, wherein it would be obvious to one with ordinary skill in the art to use the invention of Stoffer et al. in a bone fracture in the human body or in a wall. The specification does not recited the criticality of the invention in use in any particular way, therefore, the intended use is not given patentable weight for it does not define structure.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kathryn Odland whose telephone number is (703) 306-3454. The examiner can normally be reached on M-F (7:30-5:00) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry A Bennett can be reached on (703) 308-0101. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9302.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

KO

Henry Bennett
Supervisory Patent Examiner
Group 3700

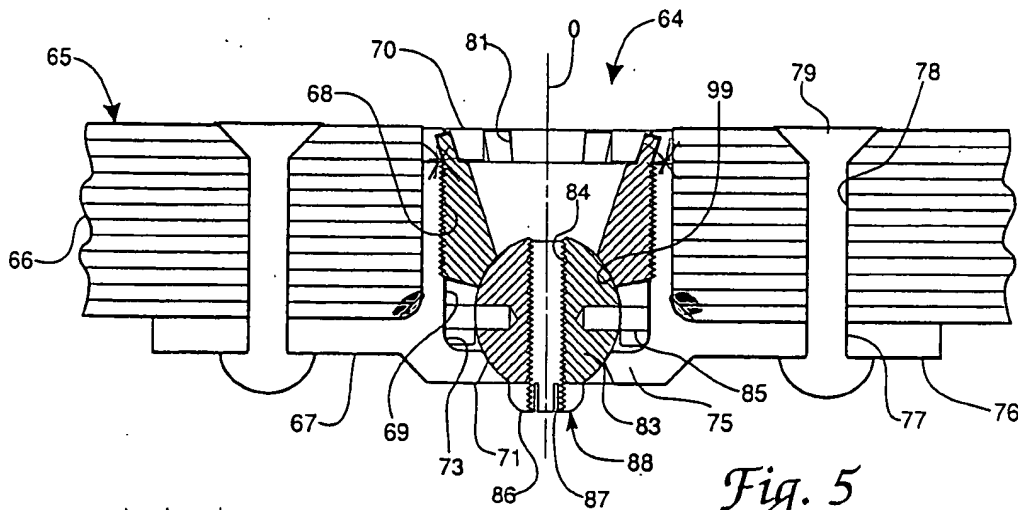
Appendix

U.S. Patent

Nov. 20, 1990

Sheet 3 of 3

4,971,497



* general area of the seat for receiving the head of the screw

● hole having an inner surface that is formed about spherically curved.

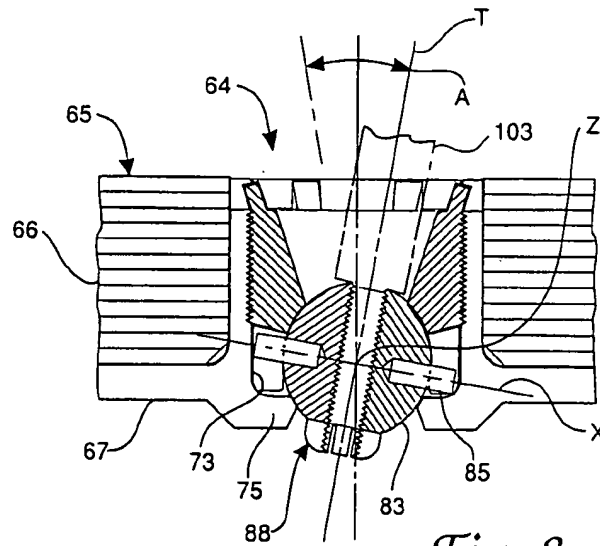
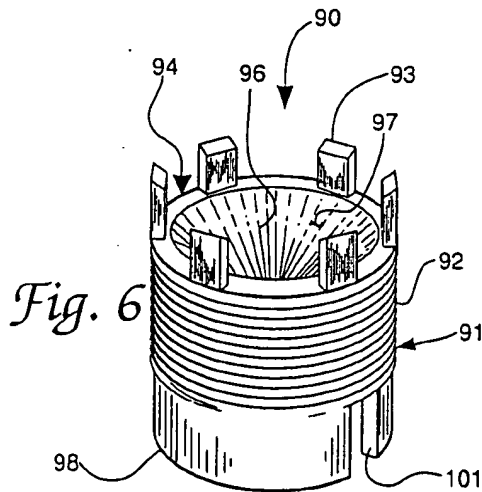


Fig. 8

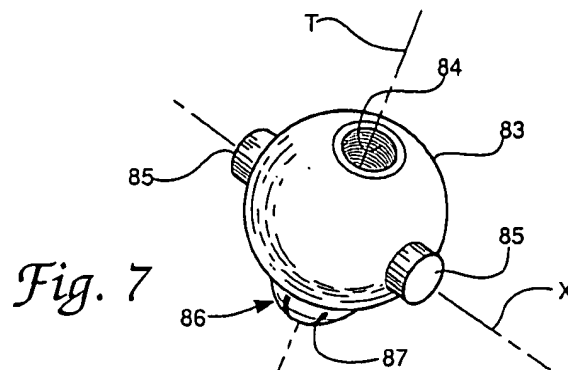


Fig. 7